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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,778	05/14/2001	Edward O. Clapper	INTL-0564-US (P11332)	8166
21906 7590 03/12/2007 TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			EXAMINER ELAHEE, MD S	
			ART UNIT 2614	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/854,778

Applicant(s)

CLAPPER, EDWARD O.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 35-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Reopening of Prosecution-New ground of Rejection After Appeal*

1. It is noted that After Final amendment filed 8/14/06 cancelled claims 1-34 and represented claims 35-43. After careful review of the remaining claims 35-43, the prior art references and the appeal brief filed 11/16/06, examiner has withdrawn the rejections as stated in Final office action mailed 7/28/06. Thus, prosecution is hereby reopened and After Final Amendment filed 8/14/06 has been entered.

2. It is noted that the Appeal brief filed 11/16/06 is defective because it did not include a complete list of claims in "Claims Appendix" section. However, since prosecution is reopened, this issue is moot.

3. The examiner has reviewed the pending claims 35-43 and performed an updated search. New prior art reference, Irani (U.S. Patent No. 6,993,570) was found. Examiner apologize for the delay of finding the reference. In light of the reference, the examiner has made a new ground of prior art rejections. Further, new 101 rejections were made according to the newly published Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (see MPEP 2106). Also, a minor antecedent basis problem for claim 41 was discovered, thus a new objection to claim 41 was made. Examiner again apologize for the delay of making the following rejections and objection.

4. The rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

*Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 38-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis

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of statutory subject matter under 35 U.S.C. 101.

Claims 38-40 recite an article comprising a medium storing instructions. Such instructions if executed, enables a system to perform a function. The claimed instructions are data structure (i.e., computer program). Data structures not claimed as embodied in computer-readable or machine-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer or machine. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Claims 38-40 fail to include practical application that produces either (1) tangible, concrete and useful result or (2) physical transformation. Therefore, since the claimed content do not comprise instructions to cause a processor to perform the method of the steps then the Applicants has not complied with 35 U.S.C 101.

### *Claim Objections*

7. Claims 41-43 are objected to because of the following informalities: Regarding claim 41, the phrase 'said retail facility' on page 3, line 4 lacks sufficient antecedent basis. The phrase does not refer to any previously claimed 'retail facility' of the claim. It appears that the phrase 'said retail facility' should be 'a retail facility'. Claims 42,43 are also objected since, these claims are dependent upon claim 41. Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 35, 38, 41 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by **Irani** (US 6,993,570).

**Irani** teaches a system/method to deliver personalized content to small footprint devices such as hand held computers, Personal data assistant (PDA), etc, (see col. 1, line 16, col.2, line 7 and fig.3, 8, 9). When a customer enters a shopping mall equipped with the system of **Irani**, the system connects the customer's PDA through a wireless local network (see col.8, lines 18-20). **Irani's** system generates and pushes personalized ads onto the customer's PDA based on the customer's current location within the mall (see col.8, lines 24-28).

Claim 35 recites a method comprising establishing a local area network in a retail facility and pushing information to a mobile customer terminal coupled to said network depending on the current location of the mobile terminal within said retail facility.

As discussed above, **Irani's** system connects the customer's PDA into a local network of the shopping mall. This connecting feature reads on the claimed "establishing a local area network in a retail facility". Further, **Irani's** system pushes personalized ads onto the customer's PDA based on the customer's current location within the mall. This pushing feature reads on the claimed "pushing information to a mobile customer terminal coupled to said network depending on the current location of the mobile terminal within said retail facility".

Claim 38 is rejected for the same reasons as discussed above with respect to claim 35.

Claim 41 recites a system comprising a processor and a storage coupled to said processor for storing instructions to establish a local area network in said retail facility between a plurality of customer terminals in said retail facility and push information to said customer terminals depending on the current location of the terminals within the retail facility.

As discussed above, since services running in the shopping mall network of **Irani's** system, the network must have a server to control/service the network (see col.8, lines 24-28). The server reads on the claimed processor. Further, the system of **Irani** can **record** specific consumers' data (see col.8, lines 13-16), so the **Irani's** system must have a storage to record the data. Furthermore, **Irani's** system connects the customer's PDA into a local network of the shopping mall. This connecting feature reads on the claimed "establishing a local area network in said retail facility between a plurality of customer terminals in said retail facility". Further, **Irani's** system pushes personalized ads onto the customer's PDA based on the customer's

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current location within the mall. This pushing feature reads on the claimed "push information to said customer terminals depending on the current location of the terminals within the retail facility".

As to Claim 43, **Irani** teaches the method of claim 41 including a global positioning device coupled to said processor (abstract; col.4, lines 43-48).

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 36, 39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Irani** in view of **Keinonen et al.** (US 6,959,207).



As to Claims 36, 39 and 42, **Irani** teaches enabling customers in said retail facility having said terminals to exchange messages with server in the form of text messages (col.8, lines 24-28, col.9, lines 54-64).

However, **Irani** does not teach customers to exchange messages with one another in the form of text messages. **Keinonen** teaches that customers can exchange messages with one another in the form of text messages (fig.1; col.3, line 60- col.4, line 7, col.8, lines 28-37, 61-67, col.9, lines 1-3). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Irani** to add the feature of exchanging messages with one another in the form of text messages as taught by **Keinonen's** invention. The motivation for the modification is to do so in order to provide communication between users such that each user can inform other user about a particular product or sale within the mall.

13. Claims 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Irani** in view of **Delph**.

As to Claims 37, 40, **Irani** does not teach enabling a terminal to access the network in response to swiping a credit card through a slot in said terminal. **Delph** teaches enabling a terminal to access the network in response to swiping a credit card through a slot in said terminal (fig.2; col.4, lines 47-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Irani** to incorporate the feature of swiping a credit card through a slot in said terminal for enabling a terminal to access the network as taught by

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**Delph's** invention. The motivation for the modification is to do so in order to provide access to a network such that a particular user can communicate other user already connected with the network.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Zellner et al.** (US 2002/0077897) teach Identify blocking service from a web advertiser; and

**Durand et al.** (US 2003/0023578) teach Content delivery.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*ME*

MD SHAFIUL ALAM ELAHEE

March 5, 2007



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